

REMARKS

I. STATUS OF CLAIMS

Claims 1-69 are pending in this application. Claims 4-17, 19-24, 26, 27, 29-34, 40-42, and 59-69 were previously withdrawn from consideration as directed to non-elected invention/species. No amendments are made in this Reply.

II. CLAIM REJECTIONS UNDER 35 U.S.C. § 103

A. Sweger in view of Matsumoto and Uchiyama

The Office maintained the rejection of claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,482,704 to Sweger et al. (“Sweger”) in view of U.S. Patent No. 6,010,689 to Matsumoto et al. (“Matsumoto”) and U.S. Patent No. 5,876,705 to Uchiyama et al. (“Uchiyama”). Office Action at page 2. In response to Applicants’ argument that Sweger fails to teach conditioning agents or anionic surfactants, the Office admits that Sweger does not expressly teach these components but maintains that these ingredients are known in the art and combinable. *Id.* at page 5, II. 15-16. Applicants respectfully disagree for the reasons of record and for the following additional reasons.

According to the Office, “Sweger et al. claimed a cosmetic skin or hair care composition comprising the modified starch, and without further limitation as to the requirements of conditioner or surfactants presented therein.” *Id.* at page 5, II. 17-19.

This rejection is apparently based on the faulty logic that because Sweger does not say that conditioning agents or anionic surfactants cannot be added, these ingredients, thus, can be added and are within the scope of Sweger's composition. *Id.* at page 5, ll. 19-21. In fact, the Office's underlying rationale for including such ingredients stems from conditioning agents and surfactants being "well known essential ingredients normally used for hair care compositions." *Id.* at page 3, ll. 6-7. If that is the case, then the *Cosmetic Ingredient Dictionary and Handbook*, which lists various well known cosmetic ingredients, could be used to defeat patentability of almost all cosmetic inventions by its listing of ingredients and properties. This is clearly not logical and is the kind of inappropriate patentability determination addressed in *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998) ("rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention.").

Moreover, the Office contends that Applicants' position on "picking and choosing" citing *In re Wesslau* is improper. *Id.* at page 5, ll. 21-22. As stated by the Office, "picking and choosing only arises when the particular combination shows unexpected or unobvious benefit that [is] residing in the combination." *Id.* at page 6, ll. 1-2. Applicants disagree with this assertion by the Office and further, disagree with the Office's application of *Wesslau*. Indeed, this case supports Applicants' position.

For example, in *Wesslau*, the applicant appealed the decision of the Board of Patent Appeals and Interferences ("the Board") affirming a Section 103 rejection based

on a combination of three cited references. 353 F.3d 238, 239, 147 U.S.P.Q. 391, 392 (C.C.P.A. 1965). In addressing similar assertions of obviousness by the Patent Office, the Court stated that “the fallacy of [the Board’s] reasoning is that no one reference suggests such a substitution, quite apart from the result which would be obtained thereby.” *Id.*, 46 U.S.P.Q. at 393 (emphasis original).

The Court further explained that “[s]uch piecemeal reconstruction of the prior art patents in the light of the appellant’s disclosure is contrary to the requirements of 35 U.S.C. § 103.” *Id.*, 147 U.S.P.Q. at 393 (citing *In re Rothermal*, 276 F.2d 393, 125 U.S.P.Q. 328 (CCPA 1960)). The Court of Claims continued that with obviousness, the question is “whether the subject matter as a whole would have been obvious to one of ordinary skill following the *teachings* of the prior art at the time the invention was made.” *Id.* 47 U.S.P.Q.2d at 393 (emphasis original).

As illustrated in *Wesslau*, piecemeal reconstruction in view of the present disclosure is impermissible. More importantly, as the Court emphasized, there must be a showing that “the subject matter as a whole would have been obvious to one ordinary skill in the art following the *teachings* of the prior art at the time the invention was made.” *Wesslau*, 353 F.3d at 241, 147 U.S.P.Q. at 393 (emphasis original). In this case, the Office’s rationale, i.e., utilizing conditioning agents and surfactants because they are well known ingredients, examines the claimed invention part by part and not “as a whole.”

For example, Matsumoto is primarily directed to hair treatment compositions containing particular types of amidopolyether functional silicones to generate certain

conditioning benefits. Matsumoto at Col. 1, ll. 26-30. Matsumoto states that “[h]air treatment composition according to the[ir] inventions may suitably take the form of shampoos, conditioners, sprays, gels, mousses or lotions.” *Id.* at Col. 2, ll. 9-12. Matsumoto then goes on to provide ingredients for each of the various forms. *Id.* at Col. 2, line 13-Col. 8, line 22. It is within these different forms and their disclosed ingredients that the Office picks and chooses among the various ingredients to arrive at the teaching of anionic surfactants. *Id.* at Col. 2, line 13. Matsumoto’s disclosure centers around the specific incorporation of an amidopolyether functional silicone and thus, directs a skilled artisan to incorporate such an ingredient into hair compositions, which is not remotely similar to the generic teaching of the use of a surfactant that the Office relies upon in this reference.

Accordingly, the Office fails to establish a *prima facie* case of obviousness and thus, Applicants respectfully request the withdrawal of the rejection.

B. Janchipraponvej in view of Sweger and Martino and in further view of Uchiyama

The Office also maintains the rejection of claims 1-3, 18, 25, 28, 38, 39, and 43-58 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,954,335 to Janchipraponvej (“Janchipraponvej”) in view of Sweger and U.S. Patent No. 6,210,689 to Martino et al. (“Martino”) and in further view of Uchiyama. Office Action at page 3. Based on Applicants’ position that the proposed modification would render the composition unsatisfactory for its intended purpose, the Office asserts that there is not a teaching away. *Id.* at page 6, ll. 10-14. According to the Office, “Uchiyama et al.

teaches that at the time the claimed invention was made, it [was] known to use anionic surfactant[s] with cationic compound[s] in shampoo conditioning composition[s]." *Id.* at page 6, ll. 14-16. Applicants respectfully disagree for the reasons of record and for the following reasons.

Recently, the Federal Circuit in *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, No. 04-1493 (Fed. Cir. June 9, 2005), addressed whether a motivation existed to combine elements already in the prior art to invalidate a particular claim of a patent under Section 103. No. 04-1493, slip op. at 8. To address such an issue, the Court outlined what is required to make an obviousness assessment. According to the Court,

in Ruiz v. A.B. Chance Co., 357 F.3d 1270, 1275 (Fed. Cir. 2004), in making the assessment of differences between the prior art and the claimed subject matter, section 103 specifically requires consideration of the claimed invention "as a whole." Inventions typically are new combinations of existing principles or features. Envtl. Designs, Ltd. v. Union Oil Co., 713 F.2d 693, 698 (Fed. Cir. 1983) (noting that "virtually all [inventions] are combinations of old elements"). The "as a whole" instruction in title 35 prevents evaluation of the invention part by part. Ruiz, 357 F.3d 1275. Without this important requirement, an obviousness assessment might successfully break an invention into its component parts, then find a prior art reference corresponding to each component. Id. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components. Further, *this improper method would discount the value of combining various existing features or principles in a new way to achieve a new result – often the essence of the invention.* Id.

Contrary to this reasoning, section 103 requires assessment of the invention as a whole. Id. This "as a whole" assessment of the invention requires a showing that an artisan of ordinary skill in the art at the time of invention, confronted by the same problems as the inventor and with no knowledge of the claimed invention, would have selected the various elements from the prior art and combined them in the claimed manner. Id. In other words, section 103

requires some suggestion or motivation, before the invention itself, to make the new combination. See In re Rouffet, 149 F.3d 1350, 1355-56 (Fed. Cir. 1998).

Id. at 8 and 9 (emphasis added).

In *Princeton*, recognizing the air of skepticism that surrounds relying on knowledge of the skilled artisan, the Court relied on the fact that the record provided “detailed analysis of the prior art and the reasons that one of ordinary skill would possess knowledge and motivation to combine these simple elements” as evidence supporting obviousness. *Id.* at 11. In contrast to the unrebutted evidence in *Princeton*, the present rejection lacks such support in that it fails to provide a detailed analysis relying on knowledge of the skilled artisan and/or evidence that the nature of the problem to be solved supported such a combination. For example, the Office relies on the primary reference of Janchipraponvej to teach quaternary ammonium compounds but admittedly, this reference lacks teachings directed to modified starch and anionic surfactants. See Office Action at pages 3-5.

The Office attempts to remedy these deficiencies with three secondary references. Moreover, in an attempt to support the combination, the Office merely asserts that it would have been obvious to modify Janchipraponvej “in order to benefit from the improved results of the amphoteric starches with regard to viscosity and thickening as taught by Sweger.” Office Action at page 5. This hardly amounts to a “detailed analysis” of the knowledge of those skilled in the art, as in *Princeton*.

Moreover, the Janchipraponvej reference must be analyzed “as a whole” and cannot be evaluated part by part. Thus, Janchipraponvej’s composition directed to a “*clear hair treating composition*” cannot be dismissed or ignored. See Abstract, Col. 5, ll. 39-42, Col. 15, ll. 47-54, Col. 20, ll. 49-54 (emphasis added).

In fact, as previously asserted and demonstrated in the declaration of Mme. MAHE, the 0.1% CEPA starch solution is not expressly identified as one Janchipraponvej’s five “essential ingredients.” See Janchipraponvej at Col. 15, ll. 47-54. Therefore, the starch solution must fall into the category of optional “other common cosmetic compositions” and/or “additives that can be incorporated with the essential ingredients.” *Id.* at Col. 15, ll. 54-61. For the 0.1% CEPA starch to be included into these categories, there, however, is a caveat in Janchipraponvej. *Id.* Janchipraponvej states that “other common cosmetic components and additives that can be incorporated with the essential ingredients, as long as the basic properties of the hair composition, such as clarity of the composition . . . , are not adversely affected.” *Id.* at Col. 15, ll. 47-54. As demonstrated in Mme. MAHE’s declaration, the added 0.1% CEPA starch solution generated a cloudy composition and by the express words of Janchipraponvej, “adversely affect[s]” the clarity of the composition.

Accordingly, under the Office’s rationale, the proposed substitution of polyacrylic starch derivatives as thickeners for CEPA-starch would render those compositions less clear and thus, unsatisfactory for their intended purpose. Where the “proposed modification would render the prior art invention being modified unsatisfactorily for its intended purpose, then there is no suggestion or motivation to make the propose

modification.” M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)).

In addition, the mere presence of each of these individual ingredients in the art merely suggests that they *can* be combined into a composition but that is not enough under obviousness standard. See *In re Rouffet*, 149 F.3d 1350, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). “The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination.” M.P.E.P. § 2143.01 (citing *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990)) (emphasis original). Thus, Janchipraponvej’s listing of optional ingredients merely provides for a number of possible combinations, but fails to provide any indication of which of the many choices is likely to successfully obtain the claimed invention. This amounts to an “obvious to try” rationale that does not meet the standard under Section 103. See *In re O’Farrell*, 853 F.2d 894, 7 U.S.P.Q.2d 1673 (Fed. Cir. 1988).

To further support this position, Applicants provide herewith an additional declaration of Mme. MAHE providing additional evidence of unexpected and improved results. As shown in this declaration, compositions containing amphoteric starch according to the present invention have improved cosmetic properties than compositions containing nonionic starches. This supports the position that Janchipraponvej’s lack of a teaching directed to a modified starch, i.e., an amphoteric starch as admitted by the Office (Office Action at page 4, lines 8 and 9), cannot be based on the inclusion of known cosmetic ingredients. *Id.*

For at least these additional reasons, the Office fails to establish a *prima facie* case of obviousness and thus, Applicants respectfully request the withdrawal of the rejection.

III. CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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Attachment: Rule 132 Declaration of Mme. MAHE